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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/895,184	07/02/2001	Michinori Shinkai	35.C15633	8763

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FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

LEE, SEUNG H

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 03/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/895,184

Applicant(s)

SHINKAI, MICHINORI

Examiner

Seung H Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10-35 is/are rejected.
- 7) ☒ Claim(s) 8 and 9 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 25, 29, and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re claim 25, line 11: The phrase "said second storing step" lacks proper antecedent basis,

Re claim 29, line 12: The phrase "said second storing step" lacks proper antecedent basis,

Re claim 33, line 12: The phrase "said second storing step" lacks proper antecedent basis.

Appropriate clarification and correction is required.

4. Claims 28 and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "a second storing step" in claims 28 and 32 are is unclear. It is vague and indefinite to the examiner what the applicant is intending to describe of that the second storing step, that is, the applicant have not disclosed what is a first storing step. Therefore, the examiner will interpret the second storing step as a storing step until further clarified by applicant.

Clarification and correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3, 5-7, 10-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurata et al. (US 2002/0022990 A1)(hereinafter referred to as 'Kurata') in view of Suzuki (US 6,129,274).

Kurata teaches a image-forming system or inkjet printer (105) comprising a printing mechanism (120) controlled/executed by a printing processing circuit (115) an EEPROM (21) having a point prize data (42a-42c) serving as a first memory storing a prize data or advertisement data, a cartridge data area and a usage data area (41) serving as a second memory storing/appending information of usage of ink cartridge and/or user information into the EEPROM, the cartridge data contains a cartridge type

information serving as a size information and a usage history data such as data and times used serving as a quantity information, issuing a discount certificate based on an accumulated points, the discounted certificate are issued according to the accumulated points in the EEPROM wherein the discount certificate can be used for a exchanging free item and/or used for recent-model printer, etc., calculating the points when the cartridge are recycled means to issuing the points when the cartridge has no remaining ink therein, the EEPROM also having an unique ID wherein the ID is assigned to particular use, an access terminal (122) reading data from the EEPROM wherein the access terminal serving as a reader, a host computer (101) can read out data from EEPROM wherein the host computer serving as an external device (see Figs. 6-17, 25; paragraphs 0014, 0020, 0073, 0078, 0087, 0114-0127, 0152, and 0170).

However, Kurata fairly suggest that the appending data is advertisement information.

Suzuki teaches an IC card (10) having a coupon code storage area (94) for appending coupon information (see Figs. 1 and 4; col. 13, lines 3-15).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Suzuki to the teachings of Kurata in order to provide an improved and an enhanced system means for updating/appending coupon information constantly according to user's history data such as a usage of ink cartridge into the memory of the cartridge. Moreover, such modification would provide a user-friendly system since the accumulating redeemable point can be occurred

automatically based on the user information stored in the EEPROM of the cartridge, and therefore an obvious expedient.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kurata as modified by Suzuki as applied to claim 1 above, and further in view of De Lapa et al. (US 5,822,735)(hereinafter referred to as 'De Lapa').

The teachings of Kurata/Suzuki have been discussed above.

Although, Kurata/Suzuki teaches a system to printing coupons with advertisement information, they fail to teach or fairly suggest that the discount ticket is a multiple cut-off type discount ticket.

However, De Lapa teaches a coupon sheet having a multiple coupons thereon (see Fig. 2; col. 5, line 46- col. 6, line 60).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of De Lapa to the teachings of Kurata/Suzuki in order to provide a improved customer service means for printing the multiple cut-off coupons for customers wherein the cut-off coupons can be used in single store for purchasing a plurality of items at a reduced price and/or the cut-off coupons can be used on different stores for purchasing items at a reduced price, and therefore an obvious expedient.

Allowable Subject Matter

8. Claims 8 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

Although, the best prior art of record to Kurata, Suzuki, and De Lapa teaches the image-forming system for printing a discount information according to user history data from the memory of cartridge, however, Kurata, Suzuki, and De Lapa taken alone or in combination of other references, fail to specifically teach or fairly suggest that the advertisement information previously stored in the first memory is supplied by an advertisement supplier and wherein the discounting system has advertisement fee calculation for calculating an advertisement fee paid by the advertisement supplier according to discount rate of the purchase price of a new cartridge, wherein the advertisement fee calculation individually calculate the advertisement fee paid by each advertisement supplier on the basis of the appending information of each advertisement as set forth in claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure;

Love et al. [US 5,075,875] discloses a printer control system,

Yamashita et al. [US 6,360,206] discloses an electronic shopping system,

Naftzger [US 5,924,078] discloses a point-of-sale (POS) terminal having a memory for storing coupons,

Byerly et al. [US 6,067,524] discloses a system for appending information.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Seung H. Lee whose telephone number is (703) 308-5894. The examiner can normally be reached on Monday to Friday from 7:30 AM to 4:00 PM.

If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax-phone number for this group is (703) 308-5841 or (703) 308-7722.


Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [**michael.lee@uspto.gov**].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record

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includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.


Seung H. Lee
Art Unit 2876
March 24, 2003


MICHAEL G. LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800